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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/718,531 | 11/24/2003 | Beatrice Perron | 235208US0 | 1996 |

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| EXAMINER | |
|---|---|
| DELCOTTO, GREGORY R | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1751 | |

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/718,531 | PERRON ET AL. | |
| | Examiner | Art Unit | |
| | Gregory R. Del Cotto | 1751 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11/15/05*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-21 and 24-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21 and 24-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. Claims 1-21 and 24-26 are pending. Claims 22 and 23 have been canceled. Applicant's amendments and arguments filed 11/15/05 have been entered.

### Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 5/26/05 have been withdrawn:

The rejection of claims 1, 3, 6, 8, 9, 13, 14, 17, and 20 under 35 U.S.C. 103(a) as being unpatentable over GB 2,367,749 has been withdrawn.

### *Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8, 9, 13-17, 20, 21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofrichter et al (US 2003/0108501).

Hofrichter et al teach a shampoo composition containing 5 to about 50 percent of a surfactant, at least about 0.1 weight percent of particles having a mean particle size of les than about 300 microns, at least about 0.05 weight percent of a cationic polymer, and at least about 20 weight percent of an aqueous carrier. See paras. 10-14. The particles have a particle size from about 0.01 microns to about 80 microns and suitable particles include magnesium aluminum silicate, calcium carbonate, etc. The particles are present in no more than 20% by weight. See paras. 53-57. Additionally, the shampoos of the composition may contain a suspending agent in amounts from about 0.1% to about 10% by weight and suitable suspending agents include polyacrylamide, polyethyleneimine, etc. See para. 192 and 193.

Hofrichter et al do not teach, with sufficient specificity, a composition or method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition and use such a composition to

clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Hofrichter et al suggest a composition and method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1-3, 5-15, 17-21, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutierrez et al (US 5,955,415).

Gutierrez et al teach detergent compositions, essentially free of chlorine bleach compounds, containing a surfactant, builder, enzyme, peroxygen bleach and from about 0.00% to about 5% by weight polyethyleneimine or salts thereof. These compositions exhibit controlled and improved bleaching action on stains as well as improved storage stability, fabric safety and whitening/brightening characteristics. See Abstract. Suitable detergent builders include crystalline aluminosilicate builder materials which have a particle size from 0.2 to 4 microns. Additionally, other detergent builders include seeded builder mixtures having a 3:1 mixtures of sodium carbonate and calcium carbonate having 5 micron particle diameter. The builders comprise from about 5% to about 80% by weight of the composition. See column 13, line 65 to column 17, line 60. The polyethyleneimines suitable for use have the same general formula as recited by instant claims 7 and 18. The polyethyleneimines are suitable for use in a variety of

compositions including shampoos, conditioning shampoos, etc. See column 44, line 60 to column 45, line 10.

Gutierrez et al do not teach, with sufficient specificity, a composition and method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition and use such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Gutierrez et al suggest a composition and method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 7, 10-12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofrichter et al (US 2003/0108501) as applied to claims 1-6, 8, 9, 13-17, 20, 21, and 24-26 above, and further in view of Gutierrez et al (US 5,955,415).

Hofrichter et al are relied upon as set forth above. However, Hofrichter et al do not teach the use of the specific polyethyleneimine as recited by the instant claims.

Gutierrez et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific polyethyleneimine as recited by instant claims in the composition taught by Hofrichter et al, with a reasonable expectation of success, because, Gutierrez et al teach that specific polyethyleneimines as recited by the instant claims are useful in shampoo compositions and further, Hofrichter et al teach the use of polyethyleneimines in general.

***Response to Arguments***

With respect to Gutierrez, Applicant states that Gutierrez relates to laundry detergent compositions containing detergent builders. Additionally, Applicant states that Gutierrez expressly states that shampoo compositions, unlike his detergent compositions, do not contain "detergent builders", thereby teaching away from combining solid mineral particles and PEI in shampoos or conditioners. In response, note that, the Examiner asserts that "wherein the composition is a shampoo or a rinse-out conditioner" as recited by instant claim 1 is an intended use of the composition and is not read as a patentable limitation. Note that, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. See MPEP 2111.02. The Examiner maintains that the teachings of Gutierrez would suggest compositions containing the same components in the same proportions as recited by the instant claims. Additionally, while Gutierrez, in the background of the invention, discusses various references and that several of these references teach shampoo or

personal cleansing compositions which do not teach the use of builders, Gutierrez clearly teaches compositions containing builder materials and that these compositions are suitable as laundry detergents as well as shampoos, conditioning shampoos, etc. See column 44, line 50 to column 45, line 20. Thus, the Examiner also asserts that Gutierrez suggests shampoos, conditioning shampoos, etc., which would contain the same components in the same proportions as recited by the instant claims.

With respect to Hofrichter et al, Applicant states that nothing in Hofrichter et al recognizes any benefits associated with actually combining PEI and solid mineral particles in a shampoo or a rinse-out conditioner. In response, note that, while Hofrichter et al may not teach the use of polyethyleneimine in a shampoo composition for the same reason as Applicant, the Examiner maintains that from the teachings of Hofrichter, one of ordinary skill in the art would have been motivated to formulate a composition containing polyethyleneimine and solid mineral particles in the same proportions as recited by the instant claims. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. While there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention. See MPEP 2144.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
February 6, 2006